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10/825,535

04/15/2004

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EXAMINER

MOSSER, ROBERT E

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

09/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/825,535

Applicant(s)

WALKER ET AL.

Examiner

Robert Mosser

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                         |                                                                                        |
|-----------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                             | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/2004, 9/2007</u> . | 6) <input type="checkbox"/> Other: ____                                                |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statements submitted April 15<sup>th</sup>, 2004 and September 14<sup>th</sup>, 2007 have been reviewed by the Examiner. A copy of each statement including the Examiner's notation is included for the Applicant's records.

### ***Double Patenting***

Claims 1-34 of this application conflict with claims 1-27 of Application No. 10/822611. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Though the claims contain minor variations in terminology the language does not provide for patentably demarcation between the two applications. For instance claim 1 of the pending application "determines game content based on the geographic location and the geographic location of the sponsor" while claim 1 of the 611' application "determines game outcome based on geographic location". As the broader limitation of '611 would encompass the narrower limitation of the instant application, one could not make and use the specific species of the instant application without infringing on the broader genus as claimed by 611'.

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Further claim 4 of the 611' application is verbatim pending claim 5 of the instant application minus the reference to a "retail entitlement" of the instant application which is referenced as a "product guarantee" in the 611' application. Further Claim 20 of the 611' includes the term "product guarantees", "price level", in place of the respective terms of the instant application including "prizes" and "measure of performance". These alternative phrasings describe equivalent processes and therefore the resultant claims are also understood as providing equivalent scope.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1-26** and **34** are rejected under 35 U.S.C. 103(a) as being unpatentable over Chu (US 2004/0148221) in view of Philyaw (US 6,631,404).

Chu teaches the general networked gaming and prize system as correlated below and including the limiting of advertisement presentations to a user based on user criteria. Chu is arguably silent regarding the inclusion of targeted advertisement, this feature however is taught by the related teachings of Philyaw wherein Philyaw provides for the restriction of advertisement by geographical location of the user according to the desires of the advertisement sponsor (*Philyaw* Col 20:23-29; 23:30-42). It would have been obvious to one of ordinary skill in the art at the time of claimed invention to have incorporated the features of Philyaw into the invention of Chu because such a combination would represent a mere combination of known elements through a conventional manner to produce an expected result.

**Claims 1-5, 15-16, and 23-26:** The combination of Chu/Philyaw teaches and system and method for providing a local edition of an online game including:

- a game system (*Chu* Figure 6, Elm 155); and

- a game server in communication with the game device (*Chu* Figure 6, Para 0009); and further including:

- a processor (*Chu* Para12 & 86);;

- a first storage device in communication with the processor for storing program code wherein when the program code is executed on the processor (*Chu* Para 85) for:

- receiving of a geographic location from the gaming device (*Chu* Fig 10);

determining geographic location associated with a prize/product sponsor/merchant (*Philyaw* Col 23:33-42);

producing game content based on the geographical location of the device and sponsor/merchant (*Philyaw* Col 23:33-42, 24:55-25:10);

providing the game content to the game device (*Chu* Para 10);

determining a prize/product to offer the player based on their geographic location(*Philyaw* Col 23:33-42, 24:55-25:10), game performance (*Chu* Para 43-44), and the geographic location of the prize/product sponsor/merchant (*Philyaw* Col 23:33-42, 24:55-25:10); and

receiving a selection from the player of a prize/product offer and converting the offer into an entitlement for the respective prize/product/offer (*Chu* Para 40, 43-44)

a second storage device storing data identifying a plurality of prize/product sponsor/merchants associated with a respective geographic location and associated with at least one respective prize/product (*Chu* Para 72).

Claim 6-7: The combination of *Chu/Philyaw* additionally teaches adjusting the measure of game performance based on the play of the game (*Chu* Para 40, 43-44, 47).

Claims 8-11, and 20: The combination of *Chu/Philyaw* additionally teaches displaying the user performance in terms of points/credits that can be redeemed for merchandise (*Chu* Para 40, 47).

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**Claims 12-14:** The combination of Chu/Philyaw teaches the inclusion of player coupons awarded in response to game play actions, these coupons are understood to inherently reduce the purchase price of an item from a target or retail price based on the player's game activities as set forth above.

**Claims 17-19, and 34:** The combination of Chu/Philyaw additionally teaches presenting the player information regarding a plurality of products either from within the game, in a manner separate from the game (*Chu* Para 40, 41, 48).

**Claims 21-22:** The combination of Chu/Philyaw additionally teaches providing the user a manner to provide payment in exchanges for good (*Chu* Para 46).

**Claims 27-33** are rejected under 35 U.S.C. 103(a) as being unpatentable over Chu (US 2004/0148221) in view of Philyaw (US 6,631,404) as applied to at least claims 25-26 above and further in view of Von Kohorn (5,697,844).

The combination of Chu/Philyaw teach the presentation of downloadable gift certificates and coupons however are silent regarding allowing a user to print the coupons/certificates and the use of validation codes to authenticate these certificates. These features however are common to enabling the redemption of electronic certificates in brick and mortar establishments. In a device directed to enabling players to play online games and rewarding successful players Von Kohorn teaches the printing of coupons/certificates including validation means to provide players with prizes in a hard copy version(*Von Kohorn* Col 5:3-17, 86:20-30). It would have been obvious to one of ordinary skill in the art at the time of invention to have implemented the teachings

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of Von Kohorn into the combination of Chu/Philyaw in order to enable redemption of coupons at dining establishments or other venues where online redemption would be impractical.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/RM/  
September 18<sup>th</sup>, 2007

  
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TC378